

REMARKS

Claims 1-20 remain in the application.

The objection to claim 9 has been addressed by amendment as suggested.

Regarding the §101 rejection of claims 15-20, applicant traverses the rejection because it is not necessary to send an advertisement to a user to provide utility. The collection, storage and direction of data can be useful to establish a means for other subsequent communications. The subsequent communications are not necessary to provide utility.

Regarding the §101 rejection of claims 15-20, claims 1 and 15 have been amended to provide a computer-based aspect. The rejection of claim 20 is traversed because claim 20 as filed recites adequate computer based-facilities.

§103 Rejections

Claims 1-20 were rejected under 35 USC §103 as obvious in view of Merriman and Peppers. Applicant traverses the rejections because neither reference discloses certain of the claimed elements, because there is inadequate teaching or incentive to make the proposed combination, and because the references teach away from the combination.

Merriman discloses a method for delivering advertisements based on limited information apparently collected during users' web browsing activity. The collected information appears to be limited to information that does not include a user's name, mail address, email address, or any other personally-identifying information (the action incorrectly states that "cookies are used to identify the user.") Thus, Merriman is a familiar system for targeting delivery of advertisements to the particular user device, based on past activity by that device. The cited reference does not appear to collect, retain, or employ information that identifies users, nor that would be considered private and in need of protection.

Peppers discloses how "host systems" (which include Internet providers) can offer "privacy intermediation to prevent users from receiving unwanted email messages. The action cites the "Catalina" system, in which shoppers' purchases are recorded over time, and coupons are later issued based on past purchasing activity. The system assigns an identity code to each customer, so that customer names are known only to Catalina to prevent other companies from circumventing the system. This is simply a system that anonymizes personal data, while that data is kept in one place by a single entity that must be

trusted by the customers. The detailed shopping information is not segregated from the personally-identifying information.

The rejections are traversed first because they inadequately indicate which features of the cited references disclose the claimed elements. The action states in general terms what concepts are considered to be obvious, but fails to indicate where the actual claimed elements or steps are disclosed in either reference. There is no indication of which disclosed participants are being asserted as the claimed "first entity" and "second entity", nor which actions in the references disclose the claimed steps of receiving and transmitting, nor the other claim limitations. Just as a claim is insufficient when it merely claims a result without the method steps that achieve the result, a rejection is inadequate when it merely asserts that a result is obvious. The rejection does not point out where any of the claimed steps are found in the cited references.

Inasmuch as the rejection can be understood, applicant specifically points out that the claim 1 steps of a first entity receiving one communication from a user, and a second entity receiving a different communication from a user is not disclosed (let alone the particular communication types.) Merriman discloses only the single entity that receives anonymous browsing information. Peppers discloses only a single entity that receives user purchasing information. Neither reference discloses two different entities receiving different information from a single user. Pepper is cited for the notion that it can protect privacy information, but it fails to provide the level of privacy provided by applicant's claimed method because it aggregates the detailed behavior information (shopping history) with the personal information (shopper name) in one place that must be trusted. Applicant's method provides that these two types of information (browsing information, communication address) are kept by different entities. By this claimed system, the information is kept segregated, as neither entity needs to know the information held by the other to perform its role of generating a targeted message, or knowing the address of the person to whom to send it.

Moreover, neither reference discloses the transmission of a resulting communication (other than the collected information) from a first entity to the second entity, nor the second entity forwarding to an address received from the user.

Second, the rejection is traversed because there is inadequate teaching or incentive to modify Merriman as suggested. Why would Merriman be motivated by the privacy intermediation features

BKL AA-11 3/11/04

PATENT

disclosed by Pepper/Catalina when Merriman possesses no personally identifying information (PII) such as a user communication address? None of the information in the cited passage of Merriman is PII, and there is no privacy concern or motivation to take steps to keep this information private, nor to keep such detailed information segregated from information that would identify the user whose activities the recorded information reflects. The action asserts without basis the motivation that it would have been obvious to forward advertising material to a gatekeeper "so that relevant ads can be forwarded to the matching target users." But this is based on hindsight because only applicant's method (and not Merriman's) involves collected addresses of users to enable forwarding ads. Moreover, if "forwarding" were intended to be construed as including displaying appropriate ads to browsing users known only by their anonymous device identifier, then Merriman already fully achieves this objective, and has no motivation to look elsewhere to achieve it.

Third, even if it were desirable to modify Merriman to adopt the disclosure of Pepper, there is no indication of how this would be done, other than by hindsight to emulate applicant's invention. What features of Pepper would be adopted and why? Neither the action nor the cited references provide any guidance on these questions.

The references teach away from the combination because an unmotivated modification that provides no articulated benefit will add cost and complexity to a system, and will risk impairing the desired function of the system.

For each of the above reasons, claim 1 should be allowable.

Claims 2-14 should be allowable for the above reasons and because of the features set forth therein. Claims 2-8 and 11-14 should be allowable for the additional reason that the action fails to point out where any of the claimed features are found in the cited references. The action provides no basis for the rejection of these claims.

Claim 15 and its dependents should be allowable for the reasons noted above with respect to claim 1, and because the action fails to indicate where any of the claimed steps are disclosed in the cited reference. The action provides no basis for the rejection of these claims.

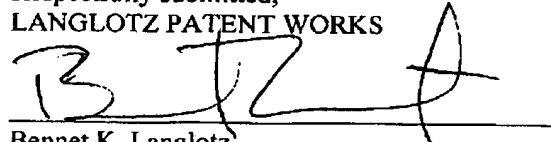
BKL AA-11 3/11/04

PATENT

Claim 20 should be allowable for the reasons noted above with respect to claim 1, and because the action fails to indicate where any of the claimed elements are disclosed in the cited reference. The action provides no basis for the rejection of these claims.

All pending claims should be allowable for the above reasons. Reconsideration of the application is respectfully requested.

Respectfully submitted,
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